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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,025	12/29/2000	Eric W. Parsons	061473/0269983 NOR-13639	1258
27498	7590	06/14/2004	EXAMINER	
PILLSBURY WINTHROP LLP 2475 HANOVER STREET PALO ALTO, CA 94304-1114			HARRELL, ROBERT B	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/753,025

Applicant(s)

PARSONS ET AL.

Examiner

Robert B. Harrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2000 et al.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: see attached Office Action.

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1. Claims 1-27 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
3. The textual portion of the specification is objected to as it is replete with incomplete blank lines (i.e., pages 1, 7, 10, exec...) that must be updated with current information (i.e., if applications, their current status such as Patent Numbers, pending, abandoned, exec...), and the specification also contains errors such as the year date for 2000 "200" on page 1 (line 10). The applicant should use the period for responding to closely review the whole of the application for accuracy and to make the required corrections. No New Matter may be entered.
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a); or

5. Claims 1-27 are rejected under 35 U.S.C. 102 (e) as being anticipated by Hellebust et al. (US 6,628,194 B1).

6. While citation to figures and text within the reference are not required, since this is an anticipated type rejection, they are none the less presented as aids and are not exclusive in nature even if this was just an anticipated type rejection. Thus the whole of the reference is cited.

7. Per claim 1, Hellebust taught a method (e.g., see figures 2 and 3) for managing messages (e.g., see Title and Abstract) provided to a user (i.e., any one of 105,106,109,110 107, and/or 108 of figure 1) of an enterprise (e.g., see col. 4 (line 12 "work")), the method comprising the steps of:

a) receiving header information (e.g., see figures 2 and 3 along with col. 3 (lines 2-10 and 44-52)) concerning a new message (i.e., e-mail) associated with the user in the enterprise (see col. 3 (line 60) to col. 4 (line 19) while keeping in mind that things such as "message type" "message origin" "source of message" "email address of the originator" all normally resided in

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the email header while the body of the email normally retained the text of the message);

b) updating a list of message information for the user based on the received header information (e.g., see figures 2 (207) and/or 3 (304) and col. 3 (lines 50-53)); and,

c) preparing a notification ("alert") based on the updated list of message information (e.g., see figure 2 (207 and 209) and figure 3 (305)); and,

d) sending the notification to a wireless device associated with the user (e.g., see figure 2 (210) and/or figure 3 (306) along with col. 3 (lines 22-28 55-59)).

8. Per claims 2 and 3, Hellebust also taught extracting information from the new message (e.g., see col. 4 (lines 13-15)), retrieving data (e.g., see col. 4 (lines 16 "address book")) associated with the sender from a contact list ("address book") being based on the retrieved data (the alert sender retains the rule set and thus has a copy of the address book information) such that the user could inherently identify and retrieve the message after being alerted by the system (i.e., dial into the POP3 Internet email server or call the phone number to which the voice messages where stored).

9. Per claims 4, 5, and 10, Hellebust also taught the new message was a new voice mail message received in a mail box associated with the user in a voice mail service, from which was inherently communicated the header information, in the enterprise (e.g., see col. 2 (line 49)), and the system also comprised a PBX associated with the message (e.g., see figure 1 (109) and col. 2 (line 52)).

10. Per claims 6 and 7, Hellebust also taught determining a type of the wireless device associated with the user and preparing the notification based on the determined type of the wireless device (e.g., see col. 3 (lines 25-35)).

11. Per claims 8 and 9, since the alert server accessed the rule set, which thus incorporated a copy of the address book, the step of retrieving the sender data inherently included the step of communicating with a contacts server in the enterprise that actually stored the rule set and then allowing the user to inherently access the message via a known path (i.e., for email the POP3 address of the email server from which the user could download the actual email message or dialed the voice message mail system).

12. Per claims 11-27, these claims do not teach or defined above the correspondingly rejected claims or citations given above, and are thus rejected for the same reasons given above. Specifically, claims 11-20 places the recited method covered above into an apparatus from which can be gien that such an apparatus was also taught per figure 1 and related citations of text given above. As for claims 21-27, the independent claims limits the type of messages covered above to "voice messages" that the user could listen to per col. 2 (lines 49-55); that is, the user uses his/her cell phone to dial the location retaining the voice message and listened to the voice message in a interactive manner inherently normal in the art (i.e., "You have three new messages. Press one for... Press two for... and so forth ").

13. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the data of this letter. Failure to

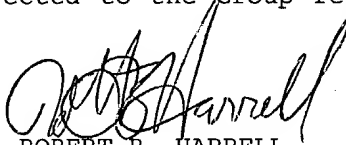
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respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (703) 305-9692. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B. Harvey, can be reached on (703) 308-9705. The fax phone numbers for the Group are (703) 746-7238 for After-Final, (703) 746-7239 for Official Papers, and (703) 746-7240 for Non-Official and Draft papers.

16. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL  
PRIMARY EXAMINER  
GROUP 2142